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OFFICE OF PETITIONS

In re Application of
BRANHAM MCDANIEL
Application No. 10/820,940
Filed: 04/09/2004
Title: METHOD AND SYSTEM FOR
CONNECTING PUBLISHERS WITH
SUBSCRIBERS THROUGH AN
INTERMEDIATE SERVER AND A USER
INSTALLED APPLICATION

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ON PETITION

This is in response to the "Petition To Withdraw Holding of Abandonment," filed December 10, 2007.

This application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed October 26, 2006, which set a three-month shortened statutory period for reply. Extensions of this time period were available under 37 CFR 1.136(a). Petitioner did not submit a timely request for an extension of time for response. Accordingly, the application became abandoned on January 27, 2007. On July 31, 2007, the Office mailed A Notice of Abandonment, stating that the application became abandoned because applicant failed to file a timely and proper reply to the non-final Office action. The Notice indicated that the reply received on April 24, 2007, comprising of proposed amendments, was considered a unofficial/proposed response. Furthermore, the Notice indicated that applicant's response of April 30, 2007, was received after the expiration of the period for reply.

In the present petition, petitioner asserts that he filed a timely reply to the outstanding Office action, accompanied by a request for a three-month extension of time and fee, in the manner indicated by the examiner.

Initially, the Office notes that the present petition contains only the typed name of joint inventor, Branham. However, the petition lacks the signatures of both inventors, Branham and McDaniel, in compliance with 37 CFR 1.4(d) and 1.33(b). The Office notes that each piece of correspondence filed in an application, patent file or other proceeding in the USPTO, which requires a person's signature, must bear one of three types of signatures: (A) handwritten signature; (B) "S-signature;" or (C) Office Electronic Filing System (EFS) character coded signature. See 37 CFR 1.4(d).

Additionally, 37 CFR 1.33(b) states, in pertinent part:

Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

- (1) A patent practitioner of record appointed in compliance with § 1.32(b);
- (2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);
- (3) An assignee as provided for under § 3.71(b) of this chapter; or
- (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

The Office records do not indicate that applicants, Branham and McDaniel, filed a power of attorney in the present application or assigned their interests. Therefore, all of the applicants must sign a petition in a joint application where the applicants have not given power of attorney to a registered attorney or agent. There is no indication that McDaniel gave power of attorney to Branham to prosecute the application on his behalf.

As a petition under 37 CFR 1.181 requires the signatures of both Branham and McDaniel, the Office cannot accept the petition because petitioner failed to comply with the requirements of 37 CFR 1.4(d) and 1.33(b). Consequently, the present petition is dismissed and will not be addressed on the merits until petitioner files a petition signed by both Branham and McDaniel.

The Office recognizes that petitioner is acting in a *pro se* capacity. Although the Office will not specifically address the merits of the petition, the Office does remind petitioner that a reply must be filed before the expiration of the period for response plus any extensions of the time period to avoid abandonment of the application, but in no situation may an applicant reply later than the six-month maximum time period set by statute.

For the reply and the request for an extension of time to be considered timely, the USPTO must have RECEIVED them on or before April 26, 2007, unless petitioner submitted the correspondence via Express Mail (37 CFR 1.10) or used a certificate of mailing or transmission (37 CFR 1.8). It does not appear that petitioner utilized the provisions of either 37 CFR 1.10 or 1.8 when mailing the reply and the extension of time request. As the Office received these documents on April 30, 2007, they were untimely.

A petitioner alleging that a paper was timely filed with the USPTO has the burden of proving the allegation by a preponderance of the evidence. Section 711.03(c)(I)(B) of the Manual for Patent Examining Procedure states:

37 CFR 1.10(c) through 1.10(e) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the

correspondence as “Express Mail.” A petition to withdraw the holding of abandonment relying upon a timely reply placed in “Express Mail” must include an appropriate petition under 37 CFR 1.10(c), (d), or (e) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the “Express Mail” procedures, the paper must be entered in PALM with the “Express Mail” date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides prima facie evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the postcard receipt.

Where a certificate of mailing under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

As it appears that the present application is abandoned, petitioner is encouraged to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a “renewed” petition under 37 CFR 1.181 to withdraw the holding of abandonment or a petition under 37 CFR 1.137(a).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action;
- (2) The petition fee as set forth in 37 CFR 1.17(m), (an additional **\$770.00 for a small entity**);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The appropriate form for filing a petition to revive an unintentionally abandoned application accompanies this communication.

As previously stated, an extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the \$510.00 extension of time fee received on April 30, 2007, was subsequent to the maximum extendable period for reply, this fee is unnecessary. The Office will refund the \$510.00 fee by treasury check in due course.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Correspondence may also be submitted via the USPTO electronic filing system.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b) – Form PTO/SB/64 and Privacy Act Statement